

IN THE DRAWINGS:

Please amend Fig. 1 as indicated in red ink on the attached drawing-correction sheet.

IN THE CLAIMS:

Without prejudice, please cancel claims 9 to 13 and please add the following new claims:

- Sub 17* →
18. (New) The method according to claim 14, wherein the carrier includes at least one of aluminum oxide and zirconium dioxide.
19. (New) The method according to claim 14, wherein the metal includes at least one of cobalt, nickel, copper, and platinum.
- CD* →
20. (New) The method according to claim 14, wherein palladium nuclei are used as seed crystals for the deposition.
21. (New) The method according to claim 20, wherein the palladium nuclei are initially deposited by reduction.
22. (New) The method according to claim 14, wherein the thermal treatment causes the deposited metal to diffuse into an inner core of the carrier to form a boundary layer.
23. (New) The method according to claim 14, wherein the thermal treatment causes adjacent particles of the carrier to fuse together in a region of the metal layer.
24. (New) The method according to claim 14, further comprising:
loading the at least one conductor track with an alternating current voltage.

REMARKS

With the cancellation of claims 9 to 13 and addition of new claims 18 to 24, claims 14 to 24 are pending in this application. Claims 14 to 17 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 14 to 17 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,700,857 to

Brandes et al. (hereafter "Brandes"). Claims 14 to 17 stand further rejected under 35 U.S.C. § 102(b) as being anticipated by Toya et al. U.S. Patent No. 4,659,960 (hereafter "Toya").

The rejection based upon 35 U.S.C. 112, first paragraph, should be withdrawn

Claims 14 to 17 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, page 2 of the final Office Action dated October 23, 2002 indicates that claim 14 "do[es] not have proper support in the original specification as filed because the specification does not provide any teaching or discussion on an evaluation device [recited in the claims] or its usage with Applicant's claimed temperature sensor ... [or] any other reference to the device and its connection or even how it is connected."

With regards to the evaluation device recited in claim 14, Figure 1 has been amended to explicitly show the evaluation device which is described on page 3, lines 21 to 24 of the original Specification, which states:

... the sensor has a layer 12, in which a conductor track 14 is embedded that is connected, in turn, via two contact points 16 to an evaluation device.

A temperature can be determined by measuring a resistance of conductor track 14 ...

Thus, there is clear and express support in the Figures and the Specification for an evaluation device that is connected to a conductor track, as well as a temperature determination by measuring the resistance of the conductor track. It is also clear that a person having ordinary skill in the art -- and even a layperson for that matter -- would understand that the evaluation device measures the resistance of the conductor track since it is the only device mentioned to be connected to the conductor track and since this mention of the connected evaluation device is immediately followed by the reference to the resistance measurement.

Moreover, the conclusion of adequate written disclosure is fully supported by the case law. In this regard, the specification as originally filed must, of course, provide a statutorily sufficient written description of the claimed subject matter to a person having ordinary skill. It does not matter, however, exactly how this is done so long as the written description requirement is satisfied. To determine whether the written description requirement is satisfied, the specification

as a whole must be considered, and, in this regard, the Federal Circuit has made clear that the “claimed subject matter need not be described *in haec verba*” in the application in order to satisfy the written description requirement. See In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (citing In re Smith, 481 F.2d 910, 914, 178 U.S.P.Q. 620, 624 (C.C.P.A. 1973)). See also M.P.E.P. § 2163.07 (stating that “[m]ere rephrasing of a passage does not constitute new matter.”).

Furthermore, the Examiner also has the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). The Manual of Patent Examining Procedure also provides that if an examiner rejects a claim based on the lack of a written description, the examiner should provide “reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.” (See id.). However, the Examiner has clearly failed to satisfy these requirements.

It is therefore respectfully submitted that claims 14 to 17 and the specification satisfy the first paragraph of 35 U.S.C. § 112, and that the rejection should therefore be withdrawn.

The rejection based upon Brandes should be withdrawn

Claims 14 to 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,700,857 to Brandes et al. (hereafter “Brandes”). In response, Applicants respectfully submit that Brandes does not anticipate or render obvious the pending claims since Brandes fails to disclose, or even suggest, each and every element in the claims. (See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987); Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). In particular, Brandes does not disclose a method of manufacturing a temperature sensor including the step of connecting an evaluation device to at least one conductor track, as recited in claim 14. Instead, Brandes merely teaches a device for uniformly heating an object (col. 1, lines 27 to 31; col. 2, lines 14 to 19), but Brandes lacks any discussion of temperature measurement or connection of an evaluation device.

The Examiner argues that the “evaluation device” recited in claim 14 is new matter, “and therefore such amendments have not been treated in this examination.” Applicants respectfully

submit that the Examiner's argument is incorrect since, as mentioned in connection with the §112 rejection, the original Specification clearly disclosed an evaluation device, and Fig. 1 has been amended to graphically show the evaluation device.

Accordingly, for at least these reasons, Applicants respectfully submit that Brandes does not anticipate, or render obvious, independent claim 14 or its dependent claims 15 to 17. Withdrawal of the rejection is therefore respectfully requested.

The rejection based upon Toya should be withdrawn

Claims 14 to 17 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by Toya. In response, Applicants respectfully submit that Toya does not anticipate the pending claims for the same reasons that Brandes does not anticipate claim 14. Specifically, Toya does not disclose a method of manufacturing a temperature sensor including the step of connecting an evaluation device to at least one conductor track. Instead, Toya merely discloses a spark plug electrode element made of sintered ceramic particles. (Col. 2, lines 51 to 55).

Accordingly, for at least these reasons, Applicants respectfully submit that Toya does not anticipate independent claim 14 or its dependent claims 15 to 17. Withdrawal of the rejection is therefore respectfully requested.

New claims 18 to 24

New claims 18 to 24 have been added to recite further features of the present invention. No new matter has been added. Support for the subject matter of claims 18 to 24 can be found throughout the specification.

CONCLUSION

In view of the foregoing, Applicants assert that the present invention is new, non-obvious, and useful. Furthermore, all issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

The paragraph beginning on page 3, line 18 of the Specification has been amended as follows:

Figure 1 illustrates one possible specific embodiment of a temperature sensor 10 according to the present invention. Such a temperature sensor 10 can, for example, be a functional element of a laminated layer sensor. In this case, the sensor has a layer 12, in which a conductor track 14 is embedded that is connected, in turn, via two contact points 16 to an evaluation device 17 [not depicted here].